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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/659,723	09/10/2003	Hirotooshi Fujisawa	S1459.70063US00	3901

7590 08/09/2006

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EXAMINER

GOKHALE, SAMEER K

ART UNIT PAPER NUMBER

2629

DATE MAILED: 08/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/659,723

Applicant(s)

FUJISAWA, HIROTOSHI

Examiner

Sameer K. Gokhale

Art Unit

2629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) 5-7, 10-14, 20-28, 36 and 37 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 15-19 and 29-33 is/are allowed.
- 6) ☒ Claim(s) 1-4, 8, 9, 34 and 35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Specification***

1. The disclosure is objected to because of the following informalities: The specification makes reference to specific claim numbers (for example on page 21, line 2) which is inappropriate due to the possibility of claims either being cancelled or changing in numbering throughout prosecution.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 34 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 34, the phrase "image formation means for forming an image of an object which is at a position to the left side of said display section..." renders the claim indefinite because it is unclear whether the image or the object is at a position to the left side of the display section, and it is also unclear whether "to the left side of said display section" means that the image or the object is being displayed or is physically to the left side of the display.

***Allowable Subject Matter***

4. Claims 15-19 and 29 – 33 are allowed.
5. The indicated allowable subject matter of claims 1 – 4, 8 and 9 is withdrawn in view of new grounds. Rejections based on the new grounds and newly cited reference(s) follow. Examiner notes that this action will be made non-final due to the new grounds of rejection.

***Claim Rejections - 35 USC § 101***

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claims 3 and 4 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Regarding claim 3, the phrase “a recording medium” on line 1 renders the claim non-statutory because it is not clear as to what type of recording medium is being claimed and therefore it lacks a practical application.

Regarding claim 4, the phrase “a program for causing a computer to execute” renders the claim non-statutory because it is just a program is being claimed and it is not clear that a practical application is achieved.

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claim 8 is rejected under 35 U.S.C. 102(e) as being anticipated by Kung (US 20020190920).

Regarding claim 8, Kung teaches an information processing apparatus, comprising: production means for producing a plurality of graphic images representative of output data (Fig. 1, see para. 10, lines 4-8, where it is clear that the PDA has the production means for producing images on its display, and where the graphic images are representative of the image data, and because the images are being outputted they are representative of output data) to be outputted to a different information processing apparatus (Fig. 1, computer 30); display means for successively displaying the first graphic images produced by a production means (Fig. 2, display 18); wherein the output data comprises image data (Fig. 2, see 14), and said display means successively displays an image based on the image data and displays one of the graphic images in the proximity of the displayed image (Fig. 1, where the displayed image substantially shows the entire produced graphic image so they are in proximity of each other).

10. Claim 35 is rejected under 35 U.S.C. 102(b) as being anticipated by Takashi et al. (JP 07-175420) (hereafter, "Takashi").

Regarding claims 35, Takashi teaches an information processing method for an information processing apparatus which includes a display section including a plurality of pixels each including an electroluminescent element for emitting light to display an image (para. 4, it is inherent that the electroluminescent device contains a display section with the aforementioned elements); a changeover step for changing over the direction of a voltage to be applied to each of the electroluminescent elements to change over driving of the electroluminescent element between driving for light emission and driving for light reception (para. 23, where it is described that during reverse bias the device detects an optical input on the display, where the reverse bias is the changeover); and a detection step for detecting an input from the outside based on electric current generated in any of the electroluminescent elements driven for light reception as a result of the changeover by said changeover means when the electroluminescent element receives light (para. 23, where the reverse bias situation is describing the detecting of an input based on electric current as a result of the reverse bias, which is the changeover).

***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 1 and 2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fields (US 6,466,145) in view of Kung (US 20020190920).

Regarding claims 1 and 2, Fields teaches an information processing apparatus and method, comprising: detection means for detecting a plurality of graphic images representative of input data inputted from a different information processing apparatus (see col. 7, lines 9-10) in response to successive display of the second graphic images on said different information processing apparatus (see col. 5, lines 22-24); and acquisition means for acquiring the input data based on the second graphic images detected by said detection means (see col. 7, lines 7-15), and Fields further teaches display means (Fig. 8, display 214) and outputting output data to a different information processing apparatus (see col. 7, lines 20-23)

However, Fields does not explicitly teach production means for producing a plurality of first graphic images representative of output data to be outputted to a different information processing apparatus; display means for successively displaying the first graphic images produced by a production means.

However, Kung does teach a personal digital assistant comprising production means for producing a plurality of first graphic images representative of output data (Fig. 1, see para. 10, lines 4-8, where it is clear that the PDA has the production means for producing images on its display, and where the graphic images are representative of the image data, and because the images are being outputted they are representative of

output data) to be outputted to a different information processing apparatus (Fig. 1, computer 30); display means for successively displaying the first graphic images produced by a production means (Fig. 2, display 18).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the teachings of Kung in the device of Fields in order to have a PDA that can produce graphic images to be transmitted to a display device, which may be the same device that it can detect graphic image data from.

13. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kung in view of Du et al. (US 20040187775) (hereafter, "Du").

Regarding claim 9, Kung teaches an information processing apparatus, comprising: production means for producing a plurality of graphic images representative of output data (Fig. 1, see para. 10, lines 4-8, where it is clear that the PDA has the production means for producing images on its display, and where the graphic images are representative of the image data, and because the images are being outputted they are representative of output data) to be outputted to a different information processing apparatus (Fig. 1, computer 30); display means for successively displaying the first graphic images produced by a production means (Fig. 2, display 18);

However, Kung does not explicitly teach outputting means for outputting sound based on music data and wherein the output data are music data, and said display means successively displays the graphic images in synchronism with said outputting means outputting sound.



However, Du does teach a PDA with the ability to output sound based on music data and wherein the output data are music data, and said display means successively displays the graphic images in synchronism with said outputting means outputting sound (see para. 3 lines 10-13, where playing MPEG movie files inherently involves outputting a sound track to go with the display of graphic images, and where sound data is the same as music data).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the sound playing capability of Du in the PDA of Kung in order to have the ability to output movie files with sound.

### ***Conclusion***

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sameer K. Gokhale whose telephone number is (571) 272-5553. The examiner can normally be reached on M-F 8:00 AM - 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amr Awad can be reached on (571) 272-7764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

SKG  
August 6, 2006

Sameer Gokhale  
Examiner  
Art Unit 2629

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PRIMARY EXAMINER

